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JUL 10 2006

Filed: August 31, 2000

Inventors:

Thomas E. Saulpaugh, et al.

Title: Method and Apparatus to Obtain Service Capability Credentials

Examiner: Chen, Shin Hon

Group/Art Unit: 2131

Att'y. Dkt. No: 5181-70400

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date indicated below.

Robert C. Kowert

Name of Registered Representative

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July 5, 2006

Signature _____

Date _____

PRE-APPEAL BRIEF REQUEST FOR REVIEW

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Dear Sir:

Appellants request review of the rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reasons stated below.

Claims 1-47 remain pending in the application. Reconsideration of the present case is earnestly requested in light of the following remarks. Please note that for brevity, only the primary arguments directed to the independent claims are presented, and that additional arguments, e.g., directed to the subject matter of the dependent claims, will be presented if and when the case proceeds to Appeal.

The Examiner rejected claims 1, 2, 5, 6 and 9-16 under 35 U.S.C. § 102(a) as being anticipated by Adams (U.S. Patent 6,718,470). The Examiner rejected claims 3 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Adams, claim 4 as being unpatentable over Adams in view of Czerwinski, et al. (“An Architecture for Secure Service Discovery Service”) (hereinafter “Czerwinski”). Claims 17-23, 25-39 and 41-47 were rejected under 35 U.S.C. § 102(a) as being clearly anticipated by Adams or under

35 U.S.C. § 103(a) as being unpatentable over Adams in view of Czerwinski. Appellants respectfully traverse these rejections and submit that the Examiner has clearly failed to present a *prima facie* rejection of Appellants' independent claims.

Regarding claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Adams teaches a system for granting security privileges by providing test criteria data so that security privilege certificates (or other authorization credentials) may be selected from among multiple subscriber privilege data. Adams teaches that certificates, such as Kerberos tickets, privilege attribute certificates, or other public key certificates (Adams, column 7, lines 48-55) may be selected from among multiple privilege data based on test criteria supplied by a relying unit (such as a software application, computer node or other entity). A selector entity may search a common repository of security privilege certificates. The selector entity then returns *any and all privilege data that meets the test criteria data*. Thus, the selector unit may return multiple certificates, each of which meets the test criteria data. *See*, Adams, column 3, lines 26-59; column 4, lines 25-36; and column 5, lines 18-46. **Adams does not mention anything about a selecting and returning a certificate that indicates a subscriber unit (client) has the right to use only an indicated portion of a services capabilities.** Instead, Adams states that any matching attribute certificates are sent as privilege data (Adams, column 6, lines 65-67). The certificates in Adams do not indicate that a client has the right to use *only* a portion that is less than all of a service's provided capabilities. No mention is made in Adams of allowing access to only a portion of a service's capabilities.

The Examiner cites column 5, lines 14-32 of Adams and refers to Adams' teachings regarding a subscriber communicating a request for another application controlled by a relying party and regarding a certificate selector analyzing a subscriber's attribute certificates to determine whether any of them contain privilege data that is consistent with privilege test criteria. **However, the teachings of Adams relied on by the Examiner do not disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service.** Instead, the Examiner's cited passage describes a particular manner in which Adams' system determines whether the subscriber certificates,

such as data representing a subscriber unit's privilege status, meet the particular required privilege test criteria data. Adams teaches that privilege test criteria data indicates "the specific privilege information necessary for the relying party to grant privilege to a subscriber unit" (Adams, column 3, lines 47-51). Thus, the portions of Adams relied on by the Examiner are not referring to a capability credential indicating that a client has the right to use only a portion of a service's capabilities. Instead, the cited portions of Adams are teaching a particular method of determining whether a subscriber's privilege status meets the particular privilege requirements of a relying unit. As noted above, the certificates in Adams do not indicate that a client has the right to use *only* a portion of a service's capabilities. In fact, Adams makes no mention regarding allowing access to only a portion of a service's capabilities.

In the Advisory Action, the Examiner argues, "the privilege data returned by the selector entity indicates that the user has the right to use only certain portion of the service's capabilities." **However, the Examiner's interpretation of Adams is incorrect.** As described above, Adams' system determines whether subscriber certificates meet particular test criteria data. In other words, Adams' teaches that a subscriber's certificates are verified to ensure that the particular type of certificate is an approved type. For example, Adams teaches that the privilege test criteria data may indicate the specific privilege information necessary for the relying part to grant privilege to the subscriber unit. The Examiner is merely speculating in hindsight regarding Adams' system. As noted above, nowhere does Adams make any mention whatsoever of a client receiving a capability credential that indicates that the client has the right to use *only a portion* of a service's capabilities, wherein *the portion is less than a total of the capabilities* provided by the first service.

Moreover, Adams is not concerned with granting a client rights to use only a portion of a service's capabilities. Instead, Adams is concerned with minimizing the number of certificates that must be transferred and also with preventing privilege data from being sent to non-privilege parties. Adams contrasts his systems with previous systems that require the subscriber to present all attribute certificates to the relying party.

Anticipation requires the presence in a single prior art reference disclosure of each and every limitation of the claimed invention, arranged as in the claim. M.P.E.P. 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The

identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). As discussed above, Adams **clearly** fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Therefore, Adams cannot be said to anticipate claim 1. Similar remarks apply to the § 102(a) rejections of claims 17 and 33 as well.

Regarding the § 102(a) rejection of claims 17 and 33, as noted above regarding the § 102(a) rejection of claim 1, Adams fails to disclose a client receiving a capability credential that indicates that the client has the right to use only a portion of a service's capabilities, wherein the portion is less than a total of the capabilities provided by the first service. Please refer to the remarks above regarding the rejection of claim 1 for a more detailed explanation regarding why Adams fails to anticipate claim 1, which apply with equal force the § 102 rejection of claims 17 and 33.

Regarding the alternative § 103(a) rejection of claims 17 and 33, the Examiner has failed to provide a proper rejection. The Examiner states, "claims 17-23, 25-39, and 41-47 encompass the same scope as claims 1-7 and 9-16" and that "claims 17-23, 25-39, and 41-47 are rejected based on the same reasons set forth in rejecting claims 1-7 and 9-16." **However, claims 1-7 and 9-16 are not rejected under § 103(a) as being unpatentable over Adams in view of Czerwinski. Thus, the Examiner has failed to provide a *prima facie* § 103(a) rejection of claims 17 and 33.**

It has been very well established that to establish a *prima facie* case of obviousness (e.g. a proper § 103(a) rejection) three basic criteria must be met. First, there must be some suggestion or motivation to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference(s) must teach or suggest all the claim limitations. (See, M.P.E.P. § 2143). The Examiner has not met any of the three basic requirements of a proper § 103(a) rejection of claims 17 and 33. Furthermore, the Examiner "bears the initial burden of factually supporting any *prima facie* conclusion of obviousness." If the Examiner does not produce a *prima facie* case, "the applicant is under no obligation to submit evidence of nonobviousness." (see, M.P.E.P. § 2142).

Applicants also note that deficiencies of Czerwinski in regard to independent claims 17 and 33 are discussed in Applicants' previously filed Appeal Brief from which the Examiner reopened prosecution with the current rejection. For the reasons stated above in regard to Adams and the reasons stated in the previous Appeal Brief in regard to Czerwinski, it is clear that neither Adams nor Czerwinski, alone or in combination, teaches or suggests all the limitations of independent claims 17 and 33.

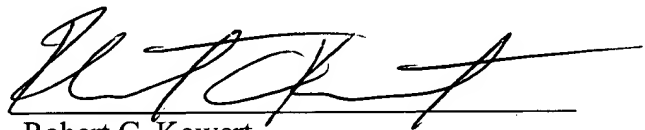
The Examiner's rejection of many of the dependent claims is additionally erroneous. For example, the cited art is clearly insufficient to support the rejection of claim 5, 6, 9 21, 22, 25, 37, 38, 41, **as discussed in detail in Applicants' previous response on pp. 4-9.**

In light of the foregoing remarks, Applicants submit the application is in condition for allowance, and notice to that effect is respectfully requested. If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above referenced application from becoming abandoned, Applicants hereby petition for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert & Goetzel PC Deposit Account No. 501505/5181-70400/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☒ Notice of Appeal

Respectfully submitted,



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